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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,651	11/06/2000	Wesley W. Whitmyer JR.	03000-P0003C	8608

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EXAMINER

LE, MIRANDA

ART UNIT PAPER NUMBER

2177

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/706,651

Applicant(s)

WHITMYER, WESLEY W.

Examiner

Miranda Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: page 5, line 11 refers to "data 18" of Figure 1, and page 5, line 15 refers to "software 18" of Figure 1.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "data request form" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 2 is objected to because of the following informalities:

Claim 2 improperly depends on itself. For purposes of clarity, examiner assumes claim 2 depends on claim 1.

Specification

4. The disclosure is objected to because of the following informalities:

This application does not contain **Detailed Description of the Invention**: See MPEP § 608.01(g). Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

6. Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

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Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. An skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice: 1) " software executing on said central computer for generating – transmitting - receiving a data backup request form" in claim 4. The description is not sufficient to understand what is a data backup request form and how it is generated, transmitted, received a reply by software executing on central computer. Undue experimentation would be needed to make a data back up request form.

7. Claims 5-6 are dependent upon claim 4, and therefore likewise rejected.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-6, are rejected under 35 U.S.C. 102(b) as being anticipated by Crawford et al. (US Patent No 5,771,354).

Crawford anticipated independent claims 1, 4, 7 by the following:

10. As per claim 1, Crawford teaches “a system for onsite backup of internet-based data...a central computer; a client computer” col. 12, lines 41-58, col. 14, line 37 to col. 15, line 56;

“a communications link between said central computer and the Internet” at col. 14, lines 17-36;

“a communications link between said client computer and the Internet” at col. 14, lines 17-36;

“at least one database containing a plurality of data records accessible by said central computer, each data record containing a client identification number” at col. 14, lines 45-67, col. 15, lines 31-56, col. 28, lines 21-51;

“software executing on said central computer for receiving a data backup request” at col. 14, lines 45-61, col. 28, lines 52-67;

“software executing on said central computer for transmitting said data backup to client computer” at col. 15, lines 32-46, col. 28, lines 52-67.

11. As per claim 4, Crawford teaches “a system for onsite backup of internet-based data...a central computer; a client computer” col. 12, lines 41-58, col. 14, line 37 to col. 15, line 56;

“a communications link between said central computer and the Internet” at col. 14, lines 17-36;

“a communications link between said client computer and the Internet” at col. 14, lines 17-36;

“at least one database containing a plurality of data records accessible by said central computer, each data record containing a client identification number” at col. 14, lines 45-67, col. 15, lines 31-56, col. 28, lines 21-51;

“software executing on said central computer for receiving commands from said client computer” at col. 14, lines 45-61, col. 27, lines 21-33;

“software executing on said central computer for receiving data from said client computer” at col. 14, lines 45-61, col. 29, lines 1-3;

“software executing on said central computer for storing said received data in said database” at col. 15, lines 41-56;

“software executing on said central computer for generating a data backup request form” at col. 14, lines 45-61;

“software executing on said central computer for transmitting said data backup request form through the internet” at col. 15, lines 32-46;

“software executing on said central computer for receiving a reply to said data backup request form” at col. 14, lines 45-61, col. 27, lines 34-50;

“software executing on said central computer for transmitting said data backup to client computer” at col. 15, lines 32-46, col. 29, lines 14-27.

12. As per claim 2, Crawford teaches “software executing on said client computer for storing said data backup in a location accessible to said client computer” at col. 12, lines 41-58.

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13. As per claim 3, Crawford teaches “software executing on said central computer for retrieving said data backup” at col. 15, lines 32-40.

14. As per claim 5, Crawford teaches “software executing on said client computer for storing said data backup in a location accessible to said client computer” at col. 12, lines 41-58.

15. As per claim 6, Crawford teaches “software executing on said central computer for retrieving said data backup” at col. 15, lines 32-40.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford et al. (US Patent No 5,771,354), as applied to claims 1-6, 8-12, 14-18, 20-23 above, in view of Borza et al. (US Patent No. 6,076,167).

18. As per claim 7, Crawford teaches “a system for onsite backup of internet-based data...a central computer; a client computer” col. 12, lines 41-58, col. 14, line 37 to col. 15, line 56;

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“a communications link between said central computer and the Internet” at col. 14, lines 17-36;

“a communications link between said client computer and the Internet” at col. 14, lines 17-36;

“at least one database containing a plurality of data records accessible by said central computer, each data record containing a client identification number” at col. 14, lines 45-67, col. 15, lines 31-56, col. 28, lines 21-51;

“software executing on said central computer for receiving commands from said client computer, for receiving data from said client computer, and for storing said data in said database” at col. 14, lines 45-61;

“software executing on said central computer for receiving a data backup request and for receiving a data format conversion request” at col. 15, lines 6-15;

“software executing on said central computer for retrieving said data from said database and for converting said data to a format corresponding to said data format conversion request” at col. 15, lines 6-14, col. 19, lines 4-27;

“software executing on said central computer for encrypting said data backup” at col. 33, line 65 to col. 34, line 3;

“software executing on said central computer for transmitting said data backup to said client computer” at col. 15, lines 32-46;

Crawford does not explicitly teach “software executing on said client computer for decrypting said data backup”. However, Borza teaches this limitation at col. 5, lines 21-67, Fig. 4.

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Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teachings of Crawford with the teachings of Borza to include “software executing on said central computer for transmitting said data backup to said client computer; and software executing on said client computer for decrypting said data backup” in order to provide a method for securely transmitting data across a network that is capable of real time modification in order to increase security.

19. As per claim 8, Crawford teaches “software executing on said client computer for storing said data backup in a location accessible to said client computer” at col. 12, lines 41-58.

20. As per claim 9, Crawford teaches “software executing on said central computer for retrieving said data backup” at col. 15, lines 32-40.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

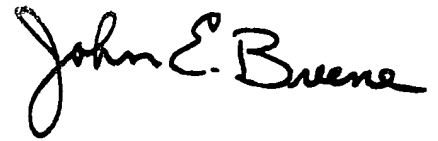
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (703) 305-3203. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax number to this Art Unit is (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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Miranda Le
Examiner-AU 2177
December 2, 2002

A handwritten signature in black ink that reads "John E. Breene". The signature is written in a cursive style with a large, looping initial "J" and a distinct "E".

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100